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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/536,514	05/25/2005	Harald Baumann	89927(58575-315072)	6468

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EXAMINER	
HAMILTON, CYNTHIA	
ART UNIT	**PAPER NUMBER**
1752	

DATE MAILED: 10/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/536,514	BAUMANN ET AL.	
	Examiner	Art Unit	
	Cynthia Hamilton	1752	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *25 May 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *24-44* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *24-34,36-38 and 40-44* is/are rejected.

7)☒ Claim(s) *29,35 and 39* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *5/25/2005*. Dated in EDAN online but stamped 10/03/2005
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

GH 10/4/05

DETAILED ACTION

1. Claim 29 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 29 is dependent upon claim 29 therefore it cannot further limit the subject mater of a previous claim.

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 29-33 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. There is no clear antecedent basis for "The radiation –sensitive element" of claim 29. There is insufficient antecedent basis for this limitation in the claims 29-33.

4. Claims 40 and 42 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. With respect to claim 40, in step (b) a mixture is applied but there is no indication as to what it is applied. In step c), there is 'drying' but what is dried is not set forth. IS the forming of free radicals in (iii) a step in the process or a property of the stabilizer? With respect to claim 42, there is another step of "applying" but again to what is not set forth. For these reasons the process of claims 40 and 42 are so vague as to be indefinite.

5. Claims 41 and 43 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In step (b) a mixture is applied but there is no indication as to what it is

applied. In step (d) a mixture is applied but there is no indication as to what it is applied. In steps c) and e), there is 'drying' but what is dried is not set forth. IS the forming of free radicals in (iii) a step in the process or a property of the stabilizer? With respect to claim 43, there is another step of "applying" but again to what is not set forth. For these reasons the process of claims 41 and 43 are so vague as to be indefinite.

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 24, 26-28, 34, 36-38, 40 and 44 are rejected under 35 U.S.C. 102(b) as being anticipated by Haubold et al (2 198 736 A). Haubold et al is cited as an X reference in the Search report at the international stage of this application. The claims 24, 26-28, 34, 36-38, 40 and 44 still read on the species set forth on the cancelled claims 1, 3-5, 11, 13-16, 18, 22 and 23. With respect to instant claims 24, 26-28, 34, 36-38, 40 and 44, Haubold et al teach forming polymeric N-oxyl structural compounds with the stable radical of N-oxyl structure and on page 4 are disclosed to be fixed, i.e.sorped, by coulombic interactions thus having a group which can be sorbed. The photopolymerizable layers of Haubold et al on page 7 are listed as containing organic compounds that have one or more polymerizable groups and free radical photoinitiators acting under the influence of light given on page 8 by example to fall within the range of 250 to 1,000 nm, i.e UV light sources and sunlight. The compositions of Haubold et al are tested for thermal stability in storage thus are tested to see if polymerization is inhibited. Thus, the disclosure of Haubold et al anticipate the instant compositions, methods and elements made

wherein the stable radical of N-oxyl is formed intot a group that is fixable by coulombic recprical as set forth by Haubold in their abstract and specification. In Haubold et al, see particularly page 3, liens 24-26, page 5, Formula III, page 6, formula IV, page 9-10 and Example 2.

8. Claims 24, 26, 29, 37-38, 40 and 44 are rejected under 35 U.S.C. 102(b) as being anticipated by Akira et al (JP 2001-222101 A) as evidenced by Machine Translation of JP 2001-222101 A. Akira et al is cited as an X reference in the Search report a the international stage of this application. With respect to instant claims 24, 26, 29, 37-38, 40 and 44, Example 8 of Akira et al anticipates the instant invention. IN Akira et al and Machine translation, see particularly Paragraph [0016], compound ST-2, paragraph [0046] compound C5, paragraph [0052], compound T-4 and Paragraph [0067] and Example 8 and Table 1.

9. Claims 24, 26, 28, 37-38, 40 and 44 are rejected under 35 U.S.C. 102(b) as being anticipated by Kunita (EP 1 091 247 A2). Kunita was cited in the International search report of this application as an X reference. With respect to instant claims 24, 26, 28, 37-38, 40 and 44, the Example on pages 117 and 118 in paragraphs 192 to 195 of Kunita anticipates the instant invention.

10. Claim 41 is rejected under 35 U.S.C. 102(b) as being anticiapted by BI et al (WO 96/34314). With respect to claim 41, the examiner notes that applicants have claimed a process with five steps but there is no claim to the order of these steps . The use of "comprising" leaves such order open to any order unless specified. With respect to claim 41, Example 3 of Bi et al anticipates the instant process wherein while drying steps are not set forth they are part of the process as the tables 3-1 and 3-2 reference stock solution and dry film wherein the solvent is the missing component, thus the process of coating the photoresist first on to the hydrophilic

substrate then drying then coating the non photosensitive Tempo containing EMA-ASA-TEMPO, Na polymer coating then drying is a species of the instant process of claim 41. To separate this process of BI et al from the process of coating the nonphotosensitive layer to the hydrophilic substrate first, applicants need to put such a limit in the claimed process. It is not now there. One kind of solution would be to make use of "..steps in the order given" along with such wording as "applying to the the optionally pretreated substrate" and/or "applying to the "applied layer of (b)". As the claims are now written application can be to anything anywhere as applicants have not specified such placing in the claim language at all.

11. Claims 24-26, 28, 38 and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bi et al (WO 96/34314). With respect to instant claims 24-26, 28, 38 and 40, Bi et al teaches a species of the instant invention with the exception of not setting forth a specific working example with the phosphate in the photosensitive layer. However, on page 19 Bi et al discloses a polymer with inhibitor and Y on polymer wherein Y can be photophate to make up the free radical quencher polymer which in the first full paragraph on page 19 is disclosed as being part of the microcapsules in the photosensitive layer of which an example is set forth in Example 1 of Bi et al. Thus, the use of phosphate quencher polymers in photosensitive compositions coated on hydrophilic substrated to form lithographic printing plate precursors is made prima facie obvious by Bi et al thus making the invention of instant claims 24-26, 28, 38 and 40 prima facie obvious over the full disclosure of Bi et al.

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Fitzgerald et al (US 5,795,698) teaches the use of amphoteric hydrogen bond-forming developability stabilizers are compounds that are miscible with the photoresist, and are

relatively non-volatile. In accord with their amphoteric nature, the developability stabilizers useful for the present invention will possess a strong hydrogen bonding site with the remainder of the molecule manifests hydrophilicity. Preferred developability stabilizers are molecules that contain ethylene oxide units and have both a hydrophilic functionality and an acid or base functionality capable of participating in the formation of a hydrogen bond. These stabilizers are demonstrative of sorping groups and are inclusive of --COOH, --PO.sub.3 H.sub.2, --PO.sub.4 H.sub.2, --SO.sub.3 H, --SO.sub.2 H, --SO.sub.4 H, --NR.sub.2 R.sub.3 (wherein R.sub.2 and R.sub.3 are alkyl), -Pyridine, --C(O)NH.sub.2, --C(S)NH.sub.2, --NHC(O)NH.sub.2, --NHC(S)NH.sub.2, or their organic salts. Fitzgerald et al makes use of antioxidant compounds in col. 9 lines 38-53 for preventing premature polymerization but they are not part of the stabilizer compounds given. Debaud et al (US 2004/0195550 A1 teach --PO(OH).sub.2 attached to tempo compounds.

13. The information disclosure statement filed on October 3, 2005 does not fully comply with the requirements of 37 CFR 1.98(b) because EP 1 176 227 has been struck from the Information Disclosure statement received October 3, 2005 because applicants did not cite it in the original disclosure, it is not in English and applicants failed to give a concise reason in English for citing it. Thus, it is struck because applicants failed to meet the requirements under 37 CFR 1.98(a)(3) because it does not include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each patent listed that is not in the English language. Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of

filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609.05(a).

14. Claims 35 and 39 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cynthia Hamilton whose telephone number is 571-272-1331. The examiner can normally be reached on Monday through Friday 9:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia H. Kelly can be reached on (571) 272-0729. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Cynthia Hamilton
Primary Examiner
Art Unit 1752

CYNTHIA HAMILTON
PRIMARY EXAMINER

September 30, 2006